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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,727	12/04/2003	Rainer Hoefer	C 2321 COGG	7177

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COGNIS CORPORATION
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EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,727	HOEFER ET AL.	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6 and 8-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6 and 8-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The rejection of claims 1, 4-6, and 8-12 under 35 U.S.C. 102(b0 as being anticipated by Adam et al, 4,524,181 is withdrawn in view of applicants' arguments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4-6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al, 5,633,042 (Nakamura) in view of Hoefer et al, US 2004/0087684 A1 (Hoefer '684) or Hoefer et al, 7,094,816 B2 (Hoefer '816).

Claims 6, 8, 10, and 12 are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113.

Nakamura teaches method of coating a glass substrate comprising providing a glass substrate, applying to the glass substrate a coating composition comprising a solventless bisphenolic epoxy and a hardener and curing the coating composition. See Examples. Nakamura does not specifically teach that the epoxy is the reaction product

of epichlorohydrin and either bisphenol A or bisphenol F, or that the hardener is water-dilutable or that his composition contains water.

Hoefer '684 and '816 teaches coating compositions comprising an epoxy resin that is a reaction product of epichlorohydrin and a component selected from bisphenol A and bisphenol F, a water-dilutable epoxy resin hardener and water. See abstracts. Hoefer '684 and '816 does not specifically teach a method of coating a glass substrate with said coating composition.

While Nakamura does not specifically teach that his epoxy is the reaction product of epichlorohydrin and either bisphenol A or bisphenol F, the fact that he teaches a bisphenolic epoxy would have provided a suggestion to the skilled artisan for the type of epoxy resin contemplated by applicants. Moreover, there is no clear showing on this record of criticality that is directly related to the instant epoxy resin. Accordingly, the compositions of Nakamura and Hoefer '684 and '816 are sufficiently close that one of ordinary skill in the art would immediately envisage substituting the compositions taught by Nakamura with one of those taught by Hoefer '684 or '816. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method of coating a glass substrate as taught by Nakamura by using the compositions taught by Hoefer '684 or '816 with the reasonable expectation of success.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6, 8, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al, 5,633,042 (Nakamura), as applied above.

As set forth above, claims 6, 8,10, and 12 are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113.

Accordingly, the examiner has interpreted these claims to embrace the end product of a glass fiber coated with a cured epoxy resin.

Nakamura, as set forth above, teaches glass fiber substrates coated with a composition comprising bisphenolic epoxy resin and a hardener and curing said coated substrate to result in the end product of a glass fiber cloth coated with a cured epoxy resin. Hence, the teachings of Nakamura anticipate the invention as claimed in product-by-process claims 6, 8, 10 and 12. There is no evidence on this record of a patentably distinct end product from the prior art products.

Response to Arguments

5. Applicant's arguments with respect to claims 6, 8, 10, and 12 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jill M. Gray
Primary Examiner
Art Unit 1774

jmg